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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,459	11/06/2003	Kaoru Tsubouchi	033498-016	8562

21839 7590 10/28/2004

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EXAMINER

BUTLER, DOUGLAS C

ART UNIT PAPER NUMBER

3683

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/701,459

Applicant(s)

TSUBOUCHI ET AL.

Examiner

Douglas C. Butler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
3. The submitted prior art has been considered. Note attached copy of Form PTO-1449.
4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of "type" in line 1 of each of claims 1-6 is indefinite. See MPEP 2173.05(b) under the heading "Relative Terminology", subheading "E. Type" wherein it is stated that the addition of the word "type" to an otherwise definite expression extends the scope of the expression so as to render it indefinite.

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In addition to the above, there are no clear antecedent bases in the claims for "said spring" of claim 1, penultimate line, claim 2, line 5, claim 3, line 3, claim 4, line 4, claim 5, line 4 and claim 6, line 4. Also, "the tip of said pin" of claim 4, line 5, claim 5, line 4 and claim 6, line 4 lacks an antecedent basis in the claims.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 3 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/701, 457 filed Nov. 6, 2003 in view of Sander et al (413 8002) or Schaefer et al (5988768).

This is a provisional obviousness-type double patenting rejection.

Note US 2004/0088975 A1 which corresponds to SN 10/701, 457.

Although the conflicting claims are not identical, it would have been obvious at the time the invention was made to one having ordinary skill in the art to which the invention pertains to modify the invention defined by claim 1 of SN 10/701, 457 re the "spring" recitation in claim 1, line 12 of SN 10/701457 to use a plurality of serially

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connected springs instead of a single spring as taught by each of the secondary references to Sander et al (note serially connected springs 8-9) and Schaefer et al (note serially connected springs 46, 47) since such modification involves replacing one well known type of spring assembly with an equivalent type of spring assembly. The assemblies operate in substantially the same manner with substantially the same effect. The use of multiple springs provides for more precise adjustment of the characteristics desired. The secondary references are considered to be analogous prior art since the particular problem of avoiding sharp or abrupt reactions to loads is avoided.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oka et al (6244049) in view of Sander et al or Schaefer et al.

principal
The ~~principal~~ reference to Oka et al discloses a hydraulic brake pressure generating or booster device with fixed shell 1, 2, input shaft 30, piston 6, 7, power plate 10, 11, 14, control valve 17 and springs 13A, 13B, 34.

Although the principal reference to Oka et al lacks the feature of claim 1, the last three lines concerning the use of "a plurality of springs arranged in series" for biasing the piston 6, 7 of Fig. 3 of Oka et al, it would have been obvious at the time the invention was made to one having ordinary skill in the art to modify the Oka et al device to use a plurality of serially connected springs as taught by each of the secondary

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references to Sander et al (note series springs 8-9 of Figs. 1-2 of Sander et al, and Schaefer et al (note series springs 46-47 of Figs. 2-3 of Schaefer et al) since such modification involves replacing one well known type of spring with an equivalent type of spring which operates in substantially the same manner with the same effect. The secondary references are considered to be analogous prior art in that the references are reasonably pertinent to the particular problem of avoiding sharp or abrupt spring reactions due to load variations.

10. Claims 4-6 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

11. Page 6, line 6 "defletion" should be changed to --deflection--.

12. Page 8, lines 19, 21 "16" should be --15--.

13. Any inquiry concerning this communication should be directed to Exmr. Butler at telephone number (703) 308-2575.



DOUGLAS C. BUTLER
PRIMARY EXAMINER



10/28/04

Butler/vs
October 25, 2004